<div align="center">REMARKS</div>

In the Office Action dated July 14, 2005, claims 1-18 and 33-42 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and claims 1-42 were rejected under § 103 over U.S. Patent No. 6,771,639 (Holden) alone.

REJECTIONS UNDER 35 U.S.C. § 101

It is respectfully submitted that claim 1 is a process claim that recites statutory subject matter. The Office Action stated that claim 1 is directed to non-statutory subject matter because the recited method "is mentally performed by hand with papers and pencils." 7/14/2005 Office Action at 2. This characterization of method claim 1 is erroneous, as claim 1 clearly recites a process that cannot just be performed "mentally." For example, the receiving task of claim 1 recites that a call request is received over *a network* from a *network entity* associated with a calling party to establish an interactive *call session*. Claim 1 further recites: based on data contained in the call request, looking up information about the calling party; receiving the information about the calling party in response to looking up the information about the calling party; and providing the received information about the calling party in the call request.

As stated by the M.P.E.P, claims define non-statutory processes if they "consist solely of mathematical operations without some claimed practical application" or "simply manipulate abstract ideas." M.P.E.P. § 2106 (8th ed., Rev. 2), at 2100-12. Claim 1 clearly does not fall into either of these categories.

As explained by *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998),

> Unpatentable mathematical algorithms are identifiable by showing they are merely abstract ideas constituting *disembodied* concepts or truths that are not "useful." From a practical standpoint, this means that to be patentable an algorithm must be applied in a "useful" way. (emphasis added).

The court further held that "the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result'--a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities

and in subsequent trades." *Id.* Similarly, in *AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999), the court held that a method claim relating to using a Boolean algorithm to determine the value of a PIC indicator is directed to statutory subject matter, because the PIC indicator represents information about a call recipient's PIC, which the court said was a useful, non-abstract result. 172 F.3d at 1358.

The receiving of a call request over a network from a network entity, looking up information about a calling party, the receiving of the information about the calling party, and the providing of the received information about the calling party in the call request clearly involve a useful, concrete, and tangible result. Therefore, it is respectfully submitted that claim 1 is directed toward statutory subject matter.

Similarly, independent claim 39 recites a method of establishing a *call session* in a *data network*, that comprises intercepting a SIP message to initiate an interactive call session, *storing* information regarding *purchases of a calling party* in the SIP message, and *transmitting* the SIP message containing the information regarding purchases of the calling party to a *presentation device*.

As with claim 1, claim 39 clearly recites at least one task that clearly involves a tangible physical object, namely a presentation device. Moreover, similar to the scenarios presented in *State Street Bank* and *AT&T*, the process defined by claim 39 is not merely an abstract idea constituting disembodied concepts or truths that are not "useful." Therefore, claim 39 and its dependent claim are directed toward statutory subject matter.

Independent claim 33 is also directed toward statutory subject matter. The Office Action stated that claim 33 is directed to non-statutory subject matter because it recited "an intangible media such as a data signal or a carrier signal which is incapable of being touched or perceived absent the tangible medium through which they are conveyed." 7/14/2005 Office Action at 2. Furthermore, the Office Action stated that claim 33 is directed to an article "which is not tangible embodied in a manner so as to be executable." *Id.* at 7. The Office Action further stated that the hardware (article) "is in an intended use statement which is the intent of the execution of the system and not the system itself that includes such hardware." *Id.*

Applicant respectfully disagrees with this rejection.

The article that comprises at least one machine-readable storage medium is an article of manufacture, with such machine-readable storage medium containing instructions that when executed cause a *system* (which is a physical tangible object) to receive a first call request from a first network entity over a network to establish a call session with a second network entity. Clearly, the subject matter of claim 33 produces a useful, concrete and tangible result.

Moreover, as provided by the M.P.E.P., "a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." M.P.E.P. § 2106 (8th ed., Rev. 2), at 2100-13. Claim 33 recites a machine-readable storage medium that contains instructions that when executed cause a system to perform the recited tasks. Thus, clearly, the instructions that are executable to cause a system to perform the recited acts constitute the data structure that defines structural and functional interrelationships between the data structure and computer software and hardware components (the instructions and the system of claim 33). In view of the foregoing, it is respectfully submitted that claim 33 recites statutory subject matter.

Independent claim 37 has been amended to recite an article comprising the at least one machine-readable storage medium and thus recites statutory subject matter for reasons similar to those of claim 33.

In view of the foregoing, withdrawal of the § 101 rejections is respectfully requested.

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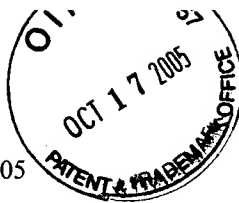
REJECTIONS UNDER 35 U.S.C. § 103

The present application and Holden, were at the time the invention of the present application was made, owned by or subject to an obligation of assignment to the same person (Nortel Networks Limited).

Therefore Holden has been disqualified as prior art pursuant to 35 U.S.C. § 103(c). Withdrawal of the § 103 rejection is respectfully requested.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (NRT.0081US).

Respectfully submitted,

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